

REMARKS

Claims 1-9 and 13-22 are now in this Application, and are presented for the Examiner's consideration.

Rejection of claims under 35 U.S.C. §112, second paragraph

Claims 1-13 were rejected under 35 U.S.C. §112, second paragraph as being indefinite.

As to claim 1, line 6, this claim has been amended to recite that the base has an upper surface, so as to provide antecedent support.

As to claim 1, line 7, this claim has been amended to recite a first downwardly extending wall and a second downwardly extending wall to provide antecedent basis.

As to claim 4, lines 1-2, this claim has been written in independent form and no longer recites the second winged projection. The reference to claims 5 and 6 in relation to this same rejection is not understood since claims 5 and 6 do not recite the winged projections.

As to claim 5, line 2, this claim has been amended to be grammatically correct by reciting that the recess (formed by the first and second downwardly extending walls) is triangular in shape. The same comments apply to claim 6 as well.

As to claims 7 and 8, line 2 of each, reference to a "plane" of the base has been changed to "the upper surface" and to "a

plane perpendicular to the upper surface" of the base, respectively, for which there is proper antecedent basis.

As to claim 9, lines 1-2, this claim now provides clear antecedent basis in view of the amendment to claim 1, line 4.

Accordingly, it is respectfully submitted that the rejection of claims 1-13 under 35 U.S.C. §112, second paragraph, has been overcome.

Claims 1-13 were rejected under 35 U.S.C. §112, first paragraph.

The base in the drawings is denoted by numeral 4. Further, the specification states "first and second downwardly extending walls 8 and 10 which form a recess 12 in the surface of base 4" (page 9, lines 2-3).

The Examiner has interpreted the sidewalls 5 in claim 1 as the claimed first and second downwardly extending walls. However, this is not true. The first and second downwardly extending walls are denoted by elements 8 and 10, which clearly form and define the recess 12. This may be the result of using the language "side walls" in the claims to define the same. In order to make this clearer, the claims now merely recite first and second downwardly extending walls.

Accordingly, it is respectfully submitted that the rejection of claims 1-13 under 35 U.S.C. §112, first paragraph, has been overcome.

Prior Art Rejection

Claims 1-13 were rejected under 35 U.S.C. §103(a) as being obvious from U.S. Patent No. 5,547,072 to Kaiser in view of U.S. Patent No. 6,029,829 to Ovadia.

Kaiser discloses a recess 58 defined by a first downwardly extending wall 62 and a second downwardly extending wall 64. There is also a jewelry engaging tab 60 that extends outwardly from first downwardly extending wall 62 into recess 58.

A problem with Kaiser, however, is that there is no means for biasing the jewelry item against the undersurface of the tab 60. This is best shown in the cross-sectional view of Fig. 3. The patent states that the ring is frictionally retained between the tab member 60 and the upper surface 64 of the recess 58. However, different rings have different thicknesses, and while this may be suitable for a thick ring, it would not be suitable for a thin ring. Further, this means that the recess 58 must be shallow or tab 60 must be sufficiently thick, to ensure that there is minimal space to provide the frictional fit. If the tab member 60 is thick, it is not very resilient for accommodating a ring.

The present invention provides a unique solution by permitting a deeper recess and using winged projections 18 and 20. By using winged projections 18 and 20, the tab member 16 can be made more rigid to provide a surface against which the ring is pressed, and the winged projections 18 and 20 can be made more resilient to permit the ring to be inserted between the tab member 16 and the winged projections 18 and 20. In this manner, the winged projections 18 and 20 function as spring members which bias the ring against the undersurface of the tab member 16. This provides a secure mounting of the ring, while easily accommodating any thickness ring.

Kaiser fails to disclose or even remotely suggest any winged projections for providing such a biased arrangement against tab member 60 thereof.

For this reason, Ovadia '829 was cited for disclosing a jewelry-engaging tab 18 and first and second winged projections 20. It was stated that it would have been obvious to modify Kaiser in view of Ovadia to better secure the jewelry within the recess.

Reasons why references should not be combined

However, Ovadia '829 provides a very different construction and different operation. In Ovadia, there are no first and second downwardly extending walls that form a recess. Rather,

Ovadia provides a jewelry pad 10 with a top wall 12 corresponding to the claimed base of the present invention. Top wall 12 is formed from a flexible and resilient plastic or rubber material. Rather than providing a recess in top wall 12, Ovadia provides a slot 16 in the shape of an "X". This slot 16 thereby forms two opposing triangular hold-down flaps 18 and two opposing triangular spring or retainer flaps 20 in the same plane. The ring is pushed down at the center of slot 16 until hold-down flaps move down and then up and through the ring to capture the ring between hold-down flaps 18 and retainer flaps 20. Alternatively, hold-down flaps 18 are picked up one at a time to capture the ring between hold-down flaps 18 and retainer flaps 20.

The Examiner has equated one hold-down flap 18 with the claimed jewelry-engaging tab and the retainer flaps 20 with the first and second winged projections.

Thus, Ovadia '829 is constructed and operates in a completely different manner from Kaiser, and it is submitted that there is no disclosure or suggestion in the references for combining the references. This is because there would be no logical reason to modify the friction fit of Kaiser with a spring fit of Ovadia.

First, as discussed above, Kaiser provides a spring fit in a very shallow recess. As seen in the drawings of Kaiser, there is

very little extra room to provide winged projections, and further, there would be no reason to do so in view of the friction fit thereof. In fact, it is questioned whether there would be sufficient room at all to provide any such winged projections.

Second, Kaiser provides a single tab 60 only. Ovadia requires TWO hold-down flaps 18. Ovadia will not work with only one hold-down flap 18. Therefore, one skilled in the art would not seek to modify Kaiser with Ovadia which would require the use of two tabs 60 from opposite directions in Kaiser.

Third, there is no recess in Ovadia, so that one skilled in the art would look at the references as being completely distinct from each other.

First Aspect

The present invention provides a modification of the Kaiser patent which is not disclosed or suggested by Ovadia. Specifically, the present invention provides that tab 16 is resiliently constructed such that it maintains near rigidity, but is flexible enough to allow for jewelry piece 6 to bend tab 16 slightly while being placed into clip 2. See page 10, line 10 of the present application. The winged projections 18 and 20, on the other hand, are much more flexible and deformable in order to

provide a spring function. See page 11, lines 9-12; and page 12, lines 4-5 and 17-18 of the present application.

This is very different from Ovadia which requires that hold-down flaps 18 be very flexible and resilient in order to operate in their intended manner. Further, in Ovadia, since hold-down flaps 18 and retainer flaps 20 are made from the same material, they have equal deformability and resilience.

Because of the near rigidity of tab 16 of the present invention, only one tab 16 is required, contrary to the teachings of Ovadia. As discussed above, Ovadia would be inoperative for its intended purpose if only one hold-down member 18 were provided, since it would be incapable of holding a ring.

In this regard, claim 1 has been amended to recite:

- a) a single tab 16 only;
- b) the single tab extending in a cantilevered manner and projecting substantially entirely across said concave surface of said recess;
- c) the single tab being relatively rigid; and
- d) a first deformable and resilient winged projection.

It is submitted that it is these limitations which provide a novel combination not disclosed or suggested by the prior art in which a ring can be biased by the winged projections against the undersurface of the single tab to securely hold the ring for display purposes.

Even if Ovadia is combined with Kaiser, the most that would be shown would be to provide equally resilient members in the same plane of Kaiser in place of the tab 60 thereof.

Second Aspect

The present application teaches that tab or projection 16 extends perpendicular away from first downwardly extending wall 8 out across recess 12. As such, tab 16 extends away from downwardly extending wall 8 at the same angle from horizontal that second downwardly extending wall 10 progresses from base 4, such that tab 16 is substantially parallel to guideway 14 forming an opening by which a user could slide jewelry piece 6 between. See page 10, lines 8-19 of the present application.

On the other hand, first and second wing projections 18 and 20 extend downwardly away from base 4 into recess 12. See page 10, lines 20-22 of the present application. As such, tab 16 extends upwardly while winged projections 18 and 20 extend downwardly. This means that winged projections 18 and 20 extend downwardly to a position below tab 16.

This is contrary to the teachings in Ovadia '829 in which triangular hold-down flaps 18 and triangular spring or retainer flaps 20 are formed in the same plane of upper wall 12 by cutting out an X-shaped slot 16. Therefore, even if Ovadia '829 could be

combined with Kaiser, the most that would be shown would be to provide winged projections at the same level in Kaiser.

As recited in amended claim 4 herein, the first winged projection extends downwardly from one wall at a position juxtaposed to the upper surface of the base into the recess toward the tab and to a position below the tab.

Third Aspect

As discussed above, the first downwardly extending wall 8 extends at an angle between 5 degrees and 30 degrees relative to a plane perpendicular to the upper surface of base 4, and in this manner, the ring is held in snug abutment against first downwardly extending wall 8 so as to be displayed at the same angle. See page 9, lines 4-5 and page 12, lines 8-16 of the present application. This functions to direct the jewel of jewelry piece 6 towards the eye of the customer. See page 13, lines 17-18 of the present application.

In this regard, new claim 14 recites the combination of:

- a) a first substantially planar downwardly extending wall and a second downwardly extending wall which together form boundaries of a recess having a concave surface,
- b) the first downwardly extending wall extending downwardly from the upper surface of the base at an angle relative to the upper surface of the base,

c) a tab extending in a cantilevered manner from the first downwardly extending wall,

d) a first winged projection extending downwardly from one wall so as to bias the item of jewelry inserted between the first winged projection and the tab upwardly against an undersurface of the tab and snugly against the first substantially planar downwardly extending wall to releasably secure the item of jewelry to the unitary molded clip at the angle of the first substantially planar downwardly extending wall.

As seen in Figs. 1 and 2 of Kaiser, the first wall 62 extends vertically down from the upper surface of the base. Further, there is no provision by which the ring can be held against the wall 62.

Ovadia does not cure these deficiencies, since Ovadia fails to provide any recess whatsoever.

Accordingly, it is respectfully submitted that the rejection of claims 1-13 under 35 U.S.C. §103(a), as applied to the claims now in the application, has been overcome.

If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the undersigned at the telephone number given below for prompt action.

In the event that this Paper is late filed, and the necessary petition for extension of time is not filed concurrently herewith, please consider this as a Petition for the requisite extension of time, and to the extent not tendered by check attached hereto, authorization to charge the extension fee, or any other fee required in connection with this Paper, to Account No. 07-1524.

The Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 07-1524.

In view of the foregoing amendments and remarks, it is respectfully submitted that Claims 1-9 and 13-22 are allowable, and early and favorable consideration thereof is solicited.

Respectfully submitted,


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